

COPY

#7
PATENT
Attorney Docket No. 23424-002
Serial No.: 09/732,008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Paul H. Robb

Serial No.: 09/732,008

Filed: December 8, 2000

For: METHOD AND SYSTEM FOR
COLLABORATING ADVISORS

Group Art Unit: 2163

Examiner: Choi, Kyle

RECEIVED
SEP 25 2001
Technology Center 2100

**REQUEST FOR RECONSIDERATION OF THE PETITION TO MAKE SPECIAL
FILED DECEMBER 8, 2000**

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This request for reconsideration of the Petition To Make Special for accelerated examination ("the Petition") is filed in response to the Decision On Petition For Accelerated Examination Under M.P.E.P. §708.02(VIII) mailed on August 22, 2001 (Paper No. 6) ("the Decision").

According to the Decision, the Petition failed on two counts. First, the Petition did not contain a statement that Applicant will make an election without traverse if the Office determines that all claims are not obviously directed to a single invention. Second, the Petition did not a detailed discussion of the references.

In response to the Decision, Applicant submits the following remarks:

Remarks

A. Applicant respectfully submits that the presented set of claims are directed to a single invention. However, if the Office determines that the claims presented are not obviously directed to a single invention, Applicant will make an election without traverse as a prerequisite to the grant of special status.

B. Applicant respectfully submits a detailed discussion of the references as follows:

1. U.S. Patent No. 5,918,217

U.S. Patent No. 5,918,217 appears to describe an invention related to the field of financial services. More specifically, the described invention provides a system that, among other things, recommends one or more specific financial products to the user of the system. *See col. 1, lines 14-18.*

According to the '217 patent, a number of computer financial products have been developed to help individuals select the best financial products to meet their needs. However, these conventional computer financial products are limited in several ways. *See col. 1, lines 32-38.*

The invention described in the '217 patent attempts to overcome the limitations of conventional computer financial products by providing a system in which a user may interactively explore how changes in one or more input decisions affect one or more output values. *See col. 2, lines 33-36.*

According to a one aspect of the invention, the system concurrently displays an input mechanism for receiving input from a user (FIG. 3, element 410), a set of output values that are based upon the input received from the user (FIG. 3, element 420), and a recommended set of financial products. (FIG. 3, element 430). Whenever the user inputs a new set of values using the input mechanism 410, the system determines a new set of recommended products and a new set of output values and displays the new output values and the new recommended set of products. *See col. 2, lines 44-50. In*

one aspect, the input mechanism 410 may be constrained based upon a set of available financial products. For example, the user may be prevented from inputting a level of risk that is outside the set of risk that is actually available. In other aspect, the output values 420 may include a "probability of achieving a financial goal." *See* col. 2, line 66 to col. 3 line 1. In another aspect, various aspects of financial risk are displayed to the user. For example, the following risks may be displayed to the user: a risk of not achieving a financial goal, a short-term risk of how much a portfolio value might decline in the near future, and a long term financial risk. *See* col. 3, lines 10-24, and FIGS. 9 and 10. In another aspect, the system displays a recommended allocation of wealth among an available set of financial products. *See* col. 3, lines 29-32, and FIGS. 12A and 12B.

In short, the invention described in the '217 patent describes a financial advisory system. The user of the system inputs certain values, such as risk tolerance, expected retirement age, amount of savings, etc. The system then uses these values to display, among other things, a set of recommended financial products.

The '217 patent does not appear to disclose or suggest, at the least, a *collaboration tool* "enabling [a] client to interact with one or more participants through the collaboration tool wherein the collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data."

2. U.S. Patent No. 5,231,571

U.S. Patent No. 5,231,571 appears to describe an invention related to the field of financial services. More specifically, the described invention is a computerized system for efficiently providing personal financial services. *See* col. 1, lines 6-9.

The computer system includes remote or local customer terminals at branch offices of financial institutions. Each customer terminal sells one or more particular financial services and each customer terminal stores financial information for the one or more particular financial services sold at that terminal. The computer system also includes at least one central or representative terminal that is provided at a central

location. The representative terminal is or can be linked to each customer terminal. A telephone link is also provided between the customer terminals and the representative terminal for voice communication. *See* col. 3 line 59 to col. 4, line 4, and FIG. 1.

The representative terminal can control each customer terminal. For example, the representative operating the representative terminal can seize control of a desired customer terminal in response to a verbal customer request over the telephone link, thereby displaying financial services information at the customer terminal under control of the representative terminal. In other words, all display of information at the customer terminal is controlled by the representative at the representative terminal in response to the one-to-one conversations the representative has with the customer over the telephone link. *See* col. 4, lines 5-20.

The '571 patent does not appear to disclose or suggest, at the least, a *collaboration tool* "enabling [a] client to interact with one or more participants through the collaboration tool wherein the collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data."

3. U.S. Patent No. 5,606,496

The '496 patent is a division of the '571 patent described above. Thus, the remarks for the '571 patent apply to the '496 patent.

4. U.S. Patent No. 5,006,998

U.S. Patent No. 5,006,998 appears to describe an invention related to the field of expert systems. More specifically, the '998 patent appears to describe an expert system that can select and determine an answer in accordance with the intention, desire and reaction of a user of the system. *See* col. 2, lines 5-10. The expert system disclosed in the '998 patent includes an inference engine and a knowledge base. The knowledge base stores expertise in a particular field and processing know-how. The expertise stored in the knowledge base includes advice rules, each of which has a premise condition part and a reply generation part. The premise condition part

includes a status of the client, the intention of the client, and the progress status of the consultation. The inference engine includes a memory for storing the following: facts clarified in an inference process, information regarding status of client, information regarding the intention of the client, information regarding a reply to the client, and information regarding progress status of the consultation. The inference engine also includes means for selecting a reply in accordance with the status of the client, the intention and the progress status, and means for offering the selected reply to the client. *See claim 1.*

The '998 patent does not appear to disclose or suggest, at the least, a *collaboration tool* "enabling [a] client to interact with one or more participants through the collaboration tool wherein the collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data."

5. U.S. Patent No. 5,890,129

U.S. Patent No. 5,890,129 discloses an information exchange system for use in the health care industry. The information exchange system is used to exchange subscriber demographics, benefit plan, eligibility, prior authorization, claims quality assurance and governmental regulatory information between an insurance company and health care provider groups. *See col. 1, lines 8-13.* The information exchange system includes an information exchange computer having access to an exchange database. The system also includes one or more provider client computers located at health care providers' offices and insurer client computers located at the insurers' offices. The client computers communicate with the information exchange computer using the Internet, direct dial-up access, or other data communication means. *See col. 3, lines 1-17 and FIG. 1.*

The information exchange system may be visualized as a hub-and-spoke system with the information exchange computer forming the hub. Spokes of the system extend out from the hub to the client computers. Each spoke provides for the translating, reformatting, transmission and receipt of information contained in a

provider's or insurer's database. The information exchange system may also include direct links between provider client computers and insurer client computers when the provider and insurer data formats are directly compatible. *See* col. 4, lines 30-42.

In operation, a subscriber provides subscriber information (e.g., demographic information) to an insurer. The insurer stores this information in a database that is accessible to the insurer client computer. The insurer client computer is operable to export the subscriber information to the exchange database, after which the information exchange computer, using push technology, transmits the subscriber information to one or more of the provider client computers. Upon receiving the subscriber information, the provider client computer stores the subscriber information in a database and enables a provider to view the information. After providing health care services to the subscriber, the provider uses the provider client computer to create a claim. A provider interface portion of the provider client computer translates and reformats the claim. The provider interface portion then transmits the claim up to the information exchange computer and there it is translated, reformatted and transmitted via push technology to an insurer or third party claim processor. *See* col. 3, lines 18-55.

The '129 patent does not appear to disclose or suggest, at the least, a *collaboration tool* "enabling [a] client to interact with one or more participants through the collaboration tool wherein the collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data."

6. U.S. Patent No. 5,819,230

U.S. Patent No. 5,819,230 relates generally to a system and method for managing a mortgage/insurance combination program that provides improved homebuyer liquidity and tax benefits that conventional combination programs. *See* col. 2, lines 28-33. More specifically, the '230 patent discloses a system and method for administering a combined mortgage loan and life insurance program to finance a real estate purchase and to purchase a life insurance product.

In one aspect, the system includes a program coordinator computer subsystem, a mortgage originator computer subsystem, a life insurance company computer subsystem, a depository company computer subsystem, and at least one mortgage insurance company computer subsystem. *See* col. 3, lines 6-14.

The program coordinator's computer subsystem sends communications to and receives communications from the following subsystems: the mortgage originator computer subsystem, the life insurance company computer subsystem, and the depository company computer subsystem. The program coordinator's computer subsystem includes a database. The database stores information about program participants, participating mortgage originators, participating life insurance companies, and participating depository companies.

The mortgage originators computer subsystem sends communications to and receives communications from the program coordinator's computer subsystem. The communications sent to and received from the program coordinator's computer subsystem include information about applications by prospective program participants, including information indicating personal information about each prospective program participant, the amount of beginning funds to be invested by each prospective program participant, and the size of an amortized mortgage loan for which each prospective program participant has applied. The mortgage originators computer subsystem also stores information about participants and prospective participants and associated amortized mortgage loans.

The insurance company's computer subsystem establishes a life insurance policy and an associated premium deposit account for each program participant who purchased a life insurance product of the life insurance company. It also sends communications to and receives communications from the program coordinator's computer subsystem about life insurance applications by prospective program participants, and about establishment of and status of the life insurance policies. It further transfers funds at scheduled times from each premium deposit account so as to pay corresponding scheduled premiums due on the associated life insurance policy.

The depository company's computer subsystem establishes a mortgage collateral account for specified ones of the program participants. It also transfers funds at scheduled times from each mortgage collateral account to a specified one of the life insurance companies so as to pay corresponding scheduled premiums due on an associated life insurance policy. It further sends communications to and receives communications from the program coordinator's computer subsystem about establishment of a mortgage collateral account for specified ones of the program participants, and sends communications to the program coordinator's computer system indicating when funds in the mortgage collateral account have been transferred to one of the life insurance companies to pay life insurance product premiums. The premium deposit account and mortgage collateral account for each program participant are funded by a single initial payment by the program participant.

The '230 patent does not appear to disclose or suggest, at the least, a *collaboration tool* "enabling [a] client to interact with one or more participants through the collaboration tool wherein the collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data."

7. U.S. Patent No. 5,873,071

U.S. Patent No. 5,873,071 discloses a computer system that is capable of facilitating exchanges of multiple commodities for multiple participants according to their goals. In the preferred implementation, the computer system is used for the exchange of financial commodities according to mean-variance portfolio goals and related portfolio constraints.

The system of the preferred embodiment implements a negotiation protocol that facilitates the intermediated exchange of commodities between any number of participants according to their goals. This negotiation protocol specifies how to search through possible combinations of exchanges between participants in order to identify the combination that balances the goals of the intermediary with the goals of the participants in the exchange. The protocol addresses both the determination of which

commodities are exchanged among participants and the amount of each commodity exchanged. It also provides a solution for the competitive equilibrium problem as it is applied to intermediated exchanges. A computer program constructed according to this protocol, together with accompanying hardware, permits participants electronically and automatically to carry out negotiations for the transfer of commodities through an intermediary.

A computer program constructed according to this invention includes electronic agents ("e-agents"), each of which represents a participant's exchange goals, and an electronic intermediary, through which the e-agents conduct electronic negotiations leading to an intermediated exchange. The e-agent program for a participant encodes the exchange goals and objectives of that participant. Participants can express their goals and objectives either (1) as an objective (or utility) function together with optional constraints, or (2) through a set of rules, which can be represented in a procedural computer language.

However expressed, the participants' objectives can be encoded in a computer program that automatically selects commodities to buy and sell from the universe of acceptable commodities on the basis of current market conditions. Systems for intermediated exchange that do not take into account participants' general goals can simply be represented as special cases of the general e-agents of this invention.

A preferred implementation represents the e-agents and the intermediary as one or more software processes residing on one or more computers. If multiple computers are used, they are interconnected by a network. These processes carry out the general negotiation of this invention by exchanging offer and counter-offer messages over this network and/or using an inter-process messages mechanism.

The '071 patent does not appear to disclose or suggest, at the least, a *collaboration tool* "enabling [a] client to interact with one or more participants through the collaboration tool wherein the collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data."

8. U.S. Patent No. 5,745,706

U.S. Patent No. 5,745,706 discloses a computer system and method for managing a spending and investment account. The computer system implements a combined spending and investment account, by which an account holder achieves a selected degree of spending flexibility and a selected investment return. The computer system monitors inflows to and outflows from the account, and investment returns achieved for the account, and indicates when adjustments to the account are required to achieve the selected investment guidelines while presenting the account holder with the selected spending flexibility. *See* col. 1 line 58 to col. 3 line 5.

In a preferred embodiment, the computer system associates a spending account with a related investment account, so that the account holder may access the spending account within spending flexibility guidelines, while an account manager controls the associated investment account within investment guidelines. The computer system monitors the resources available in the spending account and the investment account, and responsive thereto, presents the account manager with signals indicating whether investment adjustments are suggested for meeting the investment guideline and while still permitting the spending flexibility guidelines, and/or present the account holder with signals indicating whether monetary inflows are needed or outflows are permitted within the spending flexibility guidelines and while still meeting the investment guidelines. The computer system and related equipment may also periodically interrogate the account holder to determine if the spending flexibility guidelines or investment guidelines should be changed to adapt to new or altered circumstances for the account holder. *See* col. 3 lines 6-31.

While the account is active, the account holder may make deposits to and withdrawals from the account, just like another type of account. Periodically the computer system examines the transactions associated with the account and determines if the status of the account permits the investment guidelines to be met. For example, if the account holder has drawn down the account balance, it may occur that the investment guidelines cannot reasonably be met without a monetary inflow. In

this case, the computer system and related equipment may indicate to the account holder that additional monetary inflow is required. Similarly, if the account holder has increased the account balance, the computer system may indicate to the account holder that additional funds are available for spending, such as by increasing a spending limit or credit limit in the spending flexibility guidelines. The computer system is thus able to maintain the account simultaneously within the spending flexibility guidelines and the investment guidelines. *See* col. 3, lines 39-67.

The '706 patent also discloses a method of using the spending and investment account. *See* FIG. 2. In the first step, the account holder provides to a spending and investment institution an initial amount of money to be deposited in the account. Next, the account holder selects spending flexibility guidelines and investment guidelines from a set of alternative spending flexibility guidelines and investment guidelines provided by the institution. After this step, the account management program allocates the initial deposit to the spending account balance and the investment account balance, and initiates management of the investment account. The account management program then tracks and monitors spending from the spending account and investments for the investment account. At certain points, the account management program generates one or more reports about the spending account and the investment account. The account holder receives the reports and (optionally) provides monetary inflows to the account; the account management program then allocates these monetary inflows to the spending account and to the investment account. The account manager also receives the reports and (optionally) alters the allocation of the investment account to investment assets. Next, the account management program evaluates the monetary inflows to the account and the allocation of the investment account to investment assets, and alters the spending flexibility guidelines or the investment guidelines responsive thereto. *See* Col. 12, lines 10-50.

The '706 patent does not appear to disclose or suggest, at the least, a *collaboration tool* "enabling [a] client to interact with one or more participants

through the collaboration tool wherein the collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data.”

9. U.S. Patent No. 5,913,202

U.S. Patent No. 5,913,202 discloses a financial information system which extracts the most suitable product information from a wide variety of financial product data supplied by many financial institutions, so that consumers can easily find the desired financial product. *See* col. 2, lines 15-22.

In one embodiment of the financial information system, a financial delivery computer is placed between the consumers and a plurality of financial institutions. The financial delivery computer comprises a service selection/execution unit, financial institution data files, and consumer data files. The financial institution data files are used to store information on various financial products collected from the financial institutions. The consumer data files store each consumer's preference information. Upon receipt of a product selection request from a consumer terminal, the service selection/execution unit retrieves the preference information associated with the requesting consumer, and then searches the financial institution data files for appropriate product information based on the retrieved preference information. The system thus helps the consumer to make a right choice by referring to the qualified product information extracted from the industry-wide database. *See* Abstract and FIG. 1.

More specifically, the financial information system performs the following functions: collects and manages financial product information supplied by the plurality of financial institutions; stores the collected financial product information on an individual basis; registers and manages consumer preference information obtained from the consumers; stores the consumer preference information; and retrieves a collection of the financial product information that suits a preference of the requesting consumer that is described in the consumer preference information, and sends the

collection of the financial product information to the consumer terminal 30 of the requesting consumer. *See* col. 3, lines 34-50.

The '202 patent does not appear to disclose or suggest, at the least, a *collaboration tool* "enabling [a] client to interact with one or more participants through the collaboration tool wherein the collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data."

10. U.S. Patent No. 4,694,397

U.S. Patent No. 4,694,397 discloses a banking/brokerage computer interface system that enables a client that has both a banking account and a brokerage account to automatically create transaction processing between the banking and brokerage systems. *See* col. 1, lines 41-46. In other words, the banking/brokerage computer interface system enables clients having both a brokerage account and a banking account to transact both brokerage and banking activities from the brokerage office. *See* Abstract. For example, if a customer is withdrawing funds at a brokerage office using the brokerage system and his brokerage account has insufficient funds to cover the withdrawal, a banking computer system generates the appropriate transaction steps in the banking system to withdraw money from the customer's bank account and to create a transfer transaction to transfer the withdrawn money to the client's brokerage account. *See* col. 6, lines 40-46. Similarly, if the transaction initiated at the brokerage office is a deposit, the banking computer generates the appropriate transaction steps to reflect the transfer of funds from the client's brokerage account to his banking account. In one embodiment, the invention discloses a banking/brokerage system that includes: a brokerage computer system having access to a brokerage database; a banking computer system having access to a banking database; and a banking/brokerage interface and a data communications link for enabling the brokerage computer system to communicate with the banking computer system. *See* FIG. 1.

The '397 patent does not appear to disclose or suggest, at the least, a *collaboration tool* "enabling [a] client to interact with one or more participants through the collaboration tool wherein the collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data."

11. U.S. Patent No. 4,742,457

U.S. Patent No. 4,742,457 discloses a financial management system that implements a data processing methodology for effecting an improved capital structure in financial institutions. *See* col. 1, lines 9-12. More specifically, the '457 patent discloses a system and method for implementing inflation indexed deposit accounts, for matching such accounts with similarly indexed loan accounts, and for anticipating the effects of these accounts on the existing capital structures of the institution or investor. *See* col. 2, lines 49-54.

In figure 1 of the '457 patent there is shown in overall scope an operational flow chart for implementing the deposit/loan inflation-adjusting system. As therein depicted, the broad aspects of the system include an inflation-adjusted deposit account, an inflation-adjusted loan account, an intermediary institution and an account management data processor. In the most basic embodiment, the intermediary institution receives deposited funds in deposit accounts and lends funds through loan accounts. Retirement of these inflation-adjusted accounts are implemented by an account management data processor. Such data processing services the inflation-adjusting accounts in a number of ways, including the determination of their cash flow characteristics in changing inflationary environments and determining the anticipated effects of inflation on the account balance. In a preferred embodiment, an organizing company acts as a synchronizer by contacting depositors through intermediary or through a marketing agent. *See* col. 4, lines 39-65.

The '457 patent does not appear to disclose or suggest, at the least, a *collaboration tool* "enabling [a] client to interact with one or more participants

through the collaboration tool wherein the collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data.”

12. U.S. Patent No. 5,710,889

U.S. Patent No. 5,710,889 discloses a system for electronically integrating a plurality of financial services provided at different geographical locations and in different time zones, and delivering such services directly to a customer facility at any time requested by the customer. The customer connects to the system whenever desired to access each of the services, and an interface device stores and routes messages between the customers and each of the service providers at the respective times when the customers' facilities and the service providers' facilities are operative. *See Abstract.*

In other words, the '889 patent discloses a system that seamlessly interlinks the myriad of existing access services to provide comprehensive financial transaction services from single or multiple customer locations. The system provides "single window" access for a large number of financial products, as well as for multiple geographic regions. For example, a bank may have separate electronic delivery systems that provide cash management, securities, and trade products to its customers, and may have a number of these systems located throughout the world to serve different geographic regions. The system delivers the services from all of these existing systems to the customer's work site using a single interface. *See col. 3, lines 17-29.*

In a preferred embodiment, the system includes a global interface device (GID), a message repository, one or more customer facilities (CFs), a global telecommunications network (GTN), and a plurality of on-line transaction processors (OLTPs). The OLTPs may be located in a number of geographic regions around the world and may provide a variety of different financial services, including, but not limited to, cash management, securities, and trade finance services. The GTN provides a proprietary, global connecting medium between the GID and the OLTPs, as well as

between the customer facilities and the GID. In a preferred embodiment, the GTN is a private X.25 packet switch data network using permanent or switched virtual circuits as an end-to-end control mechanism through the network. *See* col. 4, lines 52-67 and FIG. 1.

The GID provides a single point of access between the customer facilities and the OLTPs. The GID includes a processing system or message switch that forwards and receives messages (e.g., transaction instructions, event and status messages, and product inquiries) between the GID 10 and the OLTPs, as well as between the GID and the CFs. *See* col. 5, lines 5-12.

The GID can provide access to the electronic delivery system of the present invention 24 hours a day, 365 days a year. That is, a customer has access to the messages stored in the repository 24 hours a day, and can send instructions and inquiries to the GID hours a day for immediate or delayed forwarding to the appropriate OLTPs. *See* col. 6, lines 23-29.

The '889 patent does not appear to disclose or suggest, at the least, a *collaboration tool* "enabling [a] client to interact with one or more participants through the collaboration tool wherein the collaboration tool further enables interaction among participants wherein interaction comprises exchange of client data."

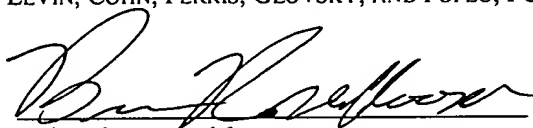
CONCLUSION

On the basis of the foregoing, the Applicant respectfully submits that the Petition now meets all of the requirements of M.P.E.P. §708.02(VIII) and respectfully requests the granting of the Petition so that the application will be taken up promptly, and respectfully solicits favorable examination at that time.

Respectfully submitted,

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY, AND POPEO, PC

By:


Brian S. Rosenbloom
Registration No. 41,276

Date: Sept. 20, 2001

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY, AND POPEO, PC
One Fountain Square
11911 Freedom Drive
Suite 400
Reston, Virginia 20190
(703) 464-4800 (Telephone)
(703) 464-4895 (Facsimile)

RES 53346v1